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In re Application of :
BELL et al. :
U.S. Application No.: 10/537,672 :
PCT No.: PCT/AU03/01610 :
Int. Filing Date: 02 December 2003 :
Priority Date: 04 December 2002 :
Attorney Docket No.: 05069 :
For: METHOD AND APPARATUS FOR :
DISPENSING OF PARTICULATE :
MATERIAL :
DECISION ON PETITION
UNDER 37 CFR 1.47(b)

This decision is issued in response to applicants' "Petition under 37 CFR 1.47" filed 03 May 2006 to accept the application without the signature of joint-inventor, Paul William Bell and the legal representative of Geoffrey Van Zwol. The petition will be treated under 37 CFR 1.47(b). The \$200 petition fee has been submitted.

BACKGROUND

On 02 December 2003, applicants filed international application PCT/AU03/01610 which claimed a priority date of 04 December 2002. The international application named William Bell and Geoffrey Van Zwol as applicants/inventors. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 June 2005.

On 06 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 03 October 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 03 May 2006, applicant filed the present petition under 37 CFR 1.47(b) and five-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of item (1). However, items (2); (3); (4); (5) and (6) have not been satisfied.

As to item (2), petitioner states that the legal representative of Geoffrey Van Zwol and inventor Paul William Bell cannot be found or reached after diligent effort.

a. Deceased Inventor Geoffrey Van Zwol

Regarding item (2), the declaration of Frank D. Giantomasso states that Inventor Geoffrey Van Zol is deceased and that a legal representative for deceased inventor cannot be found or reached after diligent effort. Applicant is advised that 37 CFR 1.47 applies only where a **known** legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)). In the present case, applicant has not provided any information regarding the deceased inventor's legal representative. In order to proceed under 35 U.S.C. 371, applicant must seek Mr. Van Zwol's current legal representative or heirs. Where there is no legal representative to the estate, any court of competent jurisdiction should appoint the legal representative for the sole purpose of prosecuting the application.

b. Inventor Paul William Bell

Petitioner states that Paul William Bell has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time

and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Paul William Bell. The declaration of Frank D. Giantomasso states that Paul William Bell has refused to execute the application in a telephone conversation dated 27 April 2006. However, petitioner has not presented evidence that a complete copy of the application (specification, claims, and drawings) has been mailed to the nonsigning inventor's last known address. As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Paul William Bell, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding item (3) above, a clear statement of the last known address of the non-signing inventor has not been provided. Additionally, last known address of the non-signing legal representative has not been provided.

Regarding item (4), a declaration in compliance with 37 CFR 1.497(a)-(b) has not been provided. The filed declaration does not comply with 37 CFR 1.497(a)-(b) in that no information has been provided on the declaration for the legal representative or heir(s). In order to proceed under 37 CFR 1.47, applicant is required to identify the non-signing party as detailed above. Additionally, the declaration should be in compliance with 37 CFR 1.42.

Regarding item (5), petitioner has not demonstrated that applicant has a proprietary interest in the invention.

Regarding item (6), a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages has not been provided.

CONCLUSION

The petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box
1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the
attention of the Office of PCT Legal Administration.



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